



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/735,093	12/12/2003	Franklin E. Boyer	UV-015 Cont. 3	1593
75563                      7590                      07/31/2008 ROPES & GRAY LLP PATENT DOCKETING 39/361 1211 AVENUE OF THE AMERICAS NEW YORK, NY 10036-8704				
			EXAMINER HOSSAIN, FARZANA E	
			ART UNIT 2623	PAPER NUMBER
			MAIL DATE 07/31/2008	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/735,093

**Applicant(s)**

BOYER ET AL.

**Examiner**

FARZANA E. HOSSAIN

**Art Unit**

2623

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 03 July 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 81-180 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 81-180 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. This office action is in response to communications filed 07/03/2008. Claims 1-80 are cancelled. Claims 81, 106, 131 and 156-180 are amended. Claims 82-105, 107-130, 132-155 have been previously presented.

### ***Response to Arguments***

2. Applicant's arguments filed 07/03/2008 have been fully considered but they are not persuasive.

The applicant is traversing the 112 rejection based on that the applicant's specification discloses "a hardware system used television program guide services and features to users over the Internet in the form of multiple web pages" (Paragraph 0072 of the published application).

In response to the arguments, the examiner respectfully disagrees. The applicant's specification merely discloses a hardware system; it does not disclose a computer readable medium comprising a computer program. While it would be less complicated and more cost effective to implement the applicant's invention via a computer readable medium comprising a computer program, it is not inherent. An example provided in Bell et al (US 5,892,767, Column 8, lines 34-42) discloses that those skill in the art should understand that an invention can be primarily embodied in hardware but alternatively embodied in software, firmware or combinations thereof. The

embodiments may include gate arrays and application specific integrated circuits.

Therefore, the 112 first paragraph rejection is maintained.

3. Applicant's arguments filed 07/03/2008 have been fully considered but they are not persuasive.

Regarding Claims 81, 106, 131 and 156, the applicant argues Venkatraman does not disclose Internet television program guide to which users registering to customize the information provided to the user because the user may indicate an interest by request notices for particular events (Page 26). The applicant argues that the office action does not specify a KSR rationale (Page 27). The applicant argues that there is no reason to combine (Page 27). The applicant also argues hindsight (Page 28).

In analogous art, the examiner respectfully disagrees. Venkatraman teaches receiving an e-mail address provided by a user via a registration web page generated by a web server to customize the information provided to the user or the user is provided with information that will be of interest (Figure 6; Column 3, lines 54-64; Column 4, lines 18-25). The applicant's specification details customization of customization that is of interest to the user via a local zip code so that viewer is looking at local television listings (Paragraphs 0081-0083). The argument that Venkatraman does not disclose registration for customization is not persuasive as Venkatraman discloses the user registering an interest to television listings targeted to the viewer based on the viewer's preferences therefore customized content is provided to the user (Column 4, lines 54-62, Column 4, lines 52-62).

Furthermore, in *KSR International Co. v. Teleflex Inc.*, 127 S.Ct 1727, No. 04-1350, slip. op. at 12 (2007), the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the suggestion to combine is to receive messages specifying predetermined events associated with the user device (Column 3, lines 54-64; Column 4, lines 52-61) so that a user has the most up to date information.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does

Art Unit: 2623

not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

***Claim Rejections - 35 USC § 112***

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 156-180 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 156 recites, "A computer-readable medium...comprising a computer program..." (lines 1-4 of claim 156). However, Applicants' disclosure lacks any teaching, explicit or inherent, of a computer-readable medium capable of comprising a computer program recorded thereon. Claims 157-180 are rejected for similar reasons.

***Claim Rejections - 35 USC § 101***

6. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

7. Claims 156-180 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as follows. Claim 156 defines a computer readable medium with a computer program recorded thereon embodying functional descriptive material. However, the claim does not define the program when executed performing the steps comprising or the method and is thus non-statutory for that reason. That is, the scope of the presently a computer readable medium with a computer program recorded thereon can range from paper on which the program is written, to a program simply contemplated and memorized by a person. The examiner suggests amending the claim to embody the program on computer-readable medium or equivalent to perform a process, steps or method when executed in order to make the claim statutory. Any amendment to the claim should be commensurate with its corresponding disclosure.

***Claim Rejections - 35 USC § 103***

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 81-84, 86, 88-109, 111, 113-134, 136, 138-159, 161 and 163-180 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein et al (US 6,002,394 and hereafter referred to as "Schein") in view of Venkatraman et al (US 6,139,177 and hereafter referred to as "Venkatraman").

Regarding claims 81, 106, 131 and 156, Schein discloses a method, and corresponding system and computer-readable medium, for configuring a web server or one or more servers on a computer network (Figure 14; Column 18, lines 7-44) to provide users of an Internet television program guide with access to web pages of television program listings and program information (Figure 14, Column 18, 7-68, the method comprising:

receiving television program listings and television program information provided by a computer system (Column 18, lines 7-27);

generating a web page of selectable television program listings with the web server by having television schedule guide accessed by the World Wide Web (Figures 16-20; Column 2, lines 40-44; Column 18, lines 44-67);

providing the user with an opportunity to access the web page of selectable television program listings over the Internet and to select a television program listing from the web page of selectable television program listings using a multimedia system including the user can scroll through and select items within the grid (Figures 16-20; Column 18, lines 44-67; Column 21, lines 19) and

providing a program information web page for the selected television program listing over the Internet in response to the user selecting the television program listing or



the guide may include other information about programs that may be provided on a website (Column 18, lines 44-67).

Schein, however, fails to specifically teach receiving an e-mail address provided by the user via a registration web page generated by the web server.

In analogous art, Venkatraman teaches receiving an e-mail address provided by a user via a registration web page generated by a web server customize the information provided to the user (Figure 6; Column 3, lines 54-64; Column 4, lines 18-25).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Schein by receiving an e-mail address provided by a user of the program information web page via a registration web page generated by a web server, as taught by Venkatraman, in order to receive messages specifying predetermined events associated with the user device (Column 3, lines 54-64; Column 4, lines 52-61) as disclosed by Venkatraman so that a user has the most up to date information.

Furthermore, in *KSR*, the Court found that if all the claimed elements are known in the prior art then one skilled in the art could have combined the elements as claimed by known methods with no change in their respective functions, and the combination would have yield predictable results to one of ordinary skill in the art at the time of the invention. No. 04-1350, slip. op. at 12.

Regarding claims 82, 107, 132 and 157, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing

Art Unit: 2623

the user with an opportunity to select a go national option for including national television program listings in the web page of selectable television program listings (Column 19, lines 11-15; Column 23, lines 39-52).

Regarding claim 83, 108, 133 and 158, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing the user with an opportunity to select a go local option for including local television program listings in the web page of selectable television program listings (Column 18, lines 52-54; Column 19, lines 1-18).

Regarding claim 84, 109, 134 and 159, Schein and Venkatraman discloses all the limitations of Claims 83, 108, 133 and 158 respectively. Schein discloses providing the user with an opportunity to select a locality for the local television listings (Column 19, lines 1-11).

Regarding claim 86, 111, 136 and 161, Schein and Venkatraman discloses all the limitations of Claims 84, 109, 134 and 159 respectively. Schein discloses wherein selecting a locality for the local television listings includes selecting a local region from a map user can select a region from which the television guide is applicable (Column 19, lines 1-18).

Regarding claim 88, 113, 138 and 163, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses wherein the web pages generated by the web server include selectable advertisements (Figure 15; Column 2, lines 45-54; Column 3, lines 1-17; Column 7, line 65-67, Column 8, lines 1-2; Column 20, lines 29-44; Column 22, lines 10-18).

Regarding claim 89, 114, 139 and 164, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a web page having a selectable record option for allowing users to record a television program selected from the web page of television program listings (Column 13, lines 8-11; Column 24, lines 25-30).

Regarding claim 90, 115, 140 and 165, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a program guide option; and providing a program guide menu web page in response to the user selecting the program guide option (Figure 16A—program guide mode; Column 22, lines 41-58—program guide 502 appears upon a user clicking a remote control device).

Regarding claim 91, 116, 141 and 166, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a movie guide Option; and providing a movie guide menu web page in response to the user selecting the movie guide option (Column 22, line 64-Column 23, line 18).

Regarding claim 92, 117, 142 and 167, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a guide television channel option; and tuning to a guide television channel in response to the user selecting the guide option (Schein: Figure 16B—channel guide mode; Column 22, lines 41-58—program guide 502 appears upon a user clicking a remote control device).

Regarding claim 93, 118, 143 and 168, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a direct tune option when a selected program is currently being broadcast; and tuning to the television channel for the selected program in response to the user selecting the direct tune option (Column 13, lines 8-12; Column 17, lines 23-34; Column 24, lines 25-30).

Regarding claim 94, 119, 144 and 169, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a selectable option to arrange the television program listings by time (Figure 16B—programs are listed in descending order by time; Column 18, lines 54-56—search and sort features; Column 24, lines 61-3—arranged chronologically).

Regarding claim 95, 120, 145 and 170, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a selectable option to arrange the television program listings by channel (Figure 16A—programs are listed in descending order by channel; Column 18, lines 54-56—search and sort features).

Regarding claim 96, 121, 146 and 171, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a selectable option to arrange the television program listings by category (Column 18, lines 54-56—search and sort features; Column 24, lines 61-3—arranged by subject matter).

Regarding claim 97, 122, 147 and 172, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing the user with an opportunity to search for television program listings using a user-defined criteria (Column 11, lines 12-46; Column 14, line 53-Column 15, line 5; Column 19, lines 19-40).

Regarding claim 98, 123, 148 and 173, Schein and Venkatraman discloses all the limitations of Claims 97, 122, 147 and 172 respectively. Schein discloses providing the user with an opportunity to search for television program listings by title (Column 19, lines 19-40—search engine allows a user to search by title).

Regarding claim 99, 124, 149 and 174, Schein and Venkatraman discloses all the limitations of Claims 97, 122, 147 and 172 respectively. Schein discloses providing the user with an opportunity to search for television program listings by actor (Column 19, lines 19-40—search engine allows a user to search by actor/actresses).

Regarding claim 100, 125, 150 and 175, Schein and Venkatraman discloses all the limitations of Claims 97, 122, 147 and 172 respectively. Schein discloses providing the user with an opportunity to search for television program listings by category (Schein: Column 19, lines 19-40—search engine allows a user to search by category).

Regarding claim 101, 126, 151 and 176, Schein and Venkatraman discloses all the limitations of Claims 97, 122, 147 and 172 respectively. Schein discloses providing the user with an opportunity to search for television program listings by description (Schein: Column 19, lines 19-40—search engine allows a user to search by description).

Regarding claim 102, 127, 152 and 177, Schein and Venkatraman discloses all the limitations of Claims 97, 122, 147 and 172 respectively. Schein discloses providing the user with an opportunity to search for television program listings by rating (Schein: Column 18, lines 58-61; Column 19, lines 19-40—search engine allows a user to search by star rating).

Regarding claim 103, 128, 153 and 178, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a selectable option for accessing a multimedia clip (Column 19, lines 41-51—video together with descriptive information).

Regarding claim 104, 129, 154 and 179, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing a hot picks web page having selectable hot picks images for promotional media clips that are available (Column 19, lines 41-51).

Regarding claim 105, 130, 155 and 180, Schein and Venkatraman discloses all the limitations of Claims 81, 106, 131 and 156 respectively. Schein discloses providing the user with an opportunity to customize the web pages provided by the web server (Column 15, lines 58-61; Column 16, lines 5-14; Column 19, lines 32-35).

10. Claims 85, 110, 135 and 160 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein (previously cited) in view of Venkatraman (previously cited), as applied to claims 84, 109, 134 and 159 above, and further in view of Levine (US 5,988,078).

Regarding claim 85, 110, 135 and 160, Schein and Venkatraman discloses all the limitations of Claims 84, 109, 134 and 159 respectively. Schein discloses that a user can select a region from which the television guide is applicable by selecting an appropriate state, city or other region (Column 19, lines 1-18), however, fail to specifically teach wherein selecting a locality for the local television listings includes accepting a zip code from which the locality is determined.

In analogous art, Levine teaches a system for a customized television programming schedule from Internet service providers. The system is designed to receive a schedule of programming from an Internet service provider (ISP). The ISP customizes information according to an entered Zip code (Column 3, lines 45-54).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the web page with television program listings of Schein and Venkatraman with the ability to customize the programming information using zip codes, as taught by Levine, in order to provide more accurate TV listing when the system being utilized over the wide area, which would allow uses to filter just local channels available in the area rather than having to go through the whole list (Levine: Column 3, lines 45-54).

11. Claims 87, 112, 137 and 162 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schein (previously cited) in view of Venkatraman (previously cited), as applied to claims 84, 109, 134 and 159 above, and further in view of Shane (US 5,793,972).

Regarding claim 87, 112, 137 and 162, Schein and Venkatraman discloses all the limitations of Claims 84, 109, 134 and 159 respectively. Schein discloses entering locality information in order to receive a local list of programs (Column 19, lines 1-18), however, fail to explicitly teach providing a pick again web page.

In analogous art, Shane teaches displaying a web page to a user when the information entered could not be found stating the user should try again (Column 7, lines 19-30).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the web page with television program listings of Schein and Venkatraman with the ability to provide a pick again web page when the information can not be found, as taught by Shane, in order to provide the user with more opportunities enter the information (Shane: Column 7, lines 19-30).

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of



Art Unit: 2623

the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to FARZANA E. HOSSAIN whose telephone number is (571)272-5943. The examiner can normally be reached on Monday to Friday 7:30 am to 3:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Kelley can be reached on 571-272-7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Annan Q Shang/  
Primary Examiner, Art Unit 2623

FEH  
July 28, 2008